

MAR 30 1992

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re \_\_\_\_\_ ) Decision on Petition  
 ) under 37 CFR § 10.2(c)  
 )

(petitioner) requests review under 37 CFR § 10.2(c) of a decision of the Director of the Office of Enrollment and Discipline, entered February 11, 1992, refusing to give petitioner a passing grade on the morning section of the examination for registration held on August 21, 1991.

BACKGROUND

The Director's decision was on a petition under 37 CFR § 10.7(c) for regrade of seven questions of the morning section. Petitioner scored 62 points on the morning section.

The decision on request for regrade added no points to petitioner's score.

Petitioner's ground for challenging the Director's decision is that his answers to Questions 8, 11, 26, 38, 41, 46 and 50 are correct and thus, his score should have been 76 points (each question being worth two points.) A minimum of eight more points, however, would be sufficient to give petitioner a passing score of 70 (out of 100).

FACTUAL REVIEW

Question 8

Question 8 reads as follows:

A final rejection was mailed on July 26, 1990. The examiner did not set a shortened statutory period for response. If a Notice of Appeal was timely filed on December 26, 1990, what would be the very last date on which the Appeal Brief could be filed, along

with a petition and the appropriate fee requesting the maximum allowable extension of time permitted under PTO rules?

- a) January 26, 1991
- b) February 26, 1991
- c) April 26, 1991
- d) June 26, 1991
- e) July 26, 1991

The model answer for Question 8 is d), citing 37 CFR 1.136(a) and MPEP 1206 [page 1200-4]. The model answer explains:

Applicant is given two months from the date the Notice of Appeal is filed to file the Appeal Brief. This time period may be extended for a maximum of four months from the date the Appeal Brief was due. Therefore, if the Notice of Appeal was filed on December 26, 1991, an Appeal Brief would be due on February 26, 1991, but the time period could be extended for a maximum of four months, in which case the Appeal Brief would be due on June 26, 1991.

Petitioner answered b).

#### Question 11

Question 11 reads as follows:

A personal interview with an examiner to discuss the merits of the claims may not be properly conducted by;

- a) The inventor, even though the attorney of record is present at the interview.
- b) An unregistered attorney who is the applicant in the application.
- c) A registered practitioner who is not an attorney or agent of record in the application, but who brings a copy of the application file to the interview.
- d) A registered practitioner who does not have a power of attorney in the application, but who is known to the examiner to be the local representative of the attorney of record in the case.
- e) An unregistered attorney who has been given the associate power of attorney in the particular

application.

The model answer for Question 11 is e), citing MPEP 713.05 [page 700-64]. Petitioner answered c).

Question 26

Question 26 reads as follows:

An Office action dated January 3, 1990, setting a three month shortened statutory period for response, was mailed to inventor Jones. The examiner rejected all of the claims in the Jones application as being obvious over a patent to Smith. On Friday, May 31, 1991, Jones filed in the PTO a complete response to the Office action along with a request and appropriate fee for a three month extension of time, and a petition and appropriate fee to revive the application for unintentional abandonment. The petition to revive will be:

- a) Denied because the application was abandoned as of Tuesday April 3, 1990.
- b) Denied because the application was abandoned as of Wednesday, April 4, 1990.
- c) Denied because the application was abandoned as of Tuesday July 3, 1990.
- d) Granted because the application was abandoned as of Tuesday, July 3, 1990.
- e) Granted because the application was abandoned as of Wednesday, July 4, 1990.

The model answer for Question 26 is b), citing 37 CFR 1.136(a). Petitioner answered d).

Question 38

Question 38 reads as follows:

Which of the following statements is true respecting product-by-process claims?

- a) A lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims than is required to make out a prima facie case of obviousness when a product is claimed in the conventional fashion.
- b) It is proper to use product-by-process only when the process is patentable.
- c) It is proper to use product-by-process claims

- only when the product is incapable of description in the conventional fashion.
- d) Product-by-process claims cannot vary in scope from each other.
  - e) Product-by-process claims may only be used in chemical cases.

The model answer for Question 38 is a), citing MPEP 706.03(e). Petitioner answered b).

Question 41

Question 41 reads as follows:

The claims in an application filed on behalf of Jones were rejected as being unpatentable under 35 U.S.C. 103 over Wilson in view of Frank. Jones gave you, a registered practitioner, power of attorney to prosecute his application. Which one of the following items of information available to you would be relevant to overcoming the rejection of the claims without modifying or amending the claims?

- a) Wilson and Frank do not teach or suggest feature A of Jones' invention which is set forth in each of the drawings and in the working examples in Jones' application, but which is not recited in any of the rejected claims.
- b) Wilson and Frank do not disclose or suggest feature B of Jones' invention which is set forth in the drawings and each working example in Jones' application and which is within the broad scope of each of the rejected claims, but not specifically set forth as a limitation in any of the claims.
- c) Jones' invention can be shown to possess unexpected superior properties over the relevant subject matter disclosed by Frank.
- d) Wilson, which was published before Frank, contains no specific reference to Frank suggesting that his invention can be modified.
- e) Wilson and Frank are both foreign patents which were published more than one year prior to the filing date of Jones' application.

The model answer for Question 41 is c), citing 35 U.S.C. 103. Petitioner answered b).

Question 46

Question 46 reads as follows:

You are a registered patent agent prosecuting a patent application filed on behalf of George. You received an Office action dated June 12, 1991 in which the examiner set a three month shortened statutory period of response and rejected all of the claims in the application under 35 U.S.C. 112 for failing to particularly point out and distinctly claim the invention. After receiving the Office action, you discovered a recently issued U.S. patent which you believe discloses and claims your client's invention. On July 25, 1991, you filed an amendment copying some of the claims from the patent for the purpose of provoking an interference. In a second Office action dated August 8, 1991, the examiner rejected the copied claims under 35 U.S.C. 112 as being based on an non-enabling disclosure and set a three month shortened statutory period for response. If no petitions for extensions of time are filed, responses to the first and second Office actions are due on \_\_\_\_\_ .

- a) September 12, 1991
- b) September 12, 1991 and November 8, 1991, respectively
- c) September 25, 1991
- d) October 25, 1991
- e) November 8, 1991

The model answer for Question 46 is b), citing MPEP 710.04 and 710.04(a). Petitioner answered e).

Question 50

Question 50 reads as follows:

Registered practitioner Smith was employed by an inventor Jones to file and prosecute a patent application. Smith quoted Jones a price of \$2800 for fees and expenses for preparing and filing the application. Smith prepared and filed the application in the PTO on August 9, 1990. The application included a combined Declaration and Power of Attorney signed by Jones authorizing Smith to prosecute the application and to conduct all business with the PTO. As of December 31, 1990, Jones had paid Smith \$2200 in fees and expenses. On January 3, 1991, Smith delivered to Jones a bill for an

outstanding balance of \$600 in fees and expenses. On February 25, 1991, Smith received an Office action dated February 22, 1991 in which the examiner rejected all of the claims in the Jones application. In the Office action, the examiner set a three month shortened statutory period for response. As of today, August 21, 1991, no response to the Office action has been filed and Jones has not paid the \$600 outstanding balance due. In which of the following situations will Smith have met his professional responsibility with regard to representing Jones.

- a) On June 17, 1991, Smith informs Jones in writing that all claims in the application have been rejected by the Office and that a response to the Office action will not be prepared because there is an outstanding balance due on his account.
- b) On March 1, 1991, Smith informs Jones in writing that he will not further prosecute the application until the balance due on the account is paid in full.
- c) Smith informs Jones today in writing that he will not prepare a response unless the \$600 outstanding balance is paid in full.
- d) Smith informs Jones today in writing that he has received an Office action and that he will no longer represent Jones because Jones has not paid the outstanding balance on his account.
- e) On March 1, 1991, Smith provides Jones with a copy of the office action and a copy of a petition to withdraw which Smith filed in the PTO on February 28, 1991, and informs Jones in writing that a response to the Office action must be filed on or before May 22, 1991 in order to avoid abandonment of the application.

The model answer for Question 50 is e), citing 37 CFR 10.40(a) and Kansas v. Mayes, 185 USPQ 624 (Kan Sp Ct 1975).  
Petitioner answered b).

#### DECISION

I find no error in the decision refusing to award petitioner credit for his answer to any of Questions 8, 11, 26, 38, 41, 46 and 50, nor do I find error in the Director's stated reasons. The following is added for emphasis.

### Question 8

Petitioner claims that the question is misleading because 37 CFR § 1.192 specifies a two-month period in which to file the appeal brief without mentioning 37 CFR § 1.136(a) and MPEP 1206 [page 1200-4]. Petitioner argues that "[o]ne cannot be expected to check every section of 37 CFR and MPEP to try to find a preferred answer, while taking a test on which time constraints are placed."

The question is clear on its face. Indeed, it would be clear even if it did not contain the concluding phrase "along with a petition and the appropriate fee requesting the maximum allowable extension of time permitted under PTO rules." The addition of this phrase strongly hints, if not states outright, that other PTO rule or rules exist which prescribe extension of the two-month period.

The Commissioner strongly disagrees with the argument that petitioner was expected to check every section of 37 CFR and the MPEP in order to find the correct answer. Rather, the Commissioner expects that all those who would represent patent applicants before the PTO first demonstrate sufficient knowledge of patent law and PTO practice. That is the purpose of the registration examination. Question 8 tests an applicant's knowledge of the provision (37 CFR § 1.136(a)) that permits, with some exceptions, an extension of time of up to four months of a shortened statutory or nonstatutory time period. Petitioner's answer to this question demonstrates that

he did not possess that knowledge.

Question 11

Petitioner suggests that his answer of c) is correct, or at least as correct as model answer e), because a registered practitioner who is not an attorney or agent of record in the application, but who brings a copy of the application file to the interview, does not have authority to bind the applicant and may have obtained the file improperly. On the other hand, petitioner argues that model answer e) is not necessarily correct because an unregistered attorney may be a registered practitioner, i.e., a registered patent agent.

Petitioner's argument assumes additional facts not presented in the question. The Directions admonish not making such assumptions.

As stated in MPEP 713.05, an examiner may hold an interview with a registered practitioner not of record in the application but who brings a copy of the application file to the interview. Also stated therein is the prohibition of Office employees from communicating with an unregistered attorney regarding an application unless it be one in which the attorney is the applicant.

Question 26

Response to the Office action was due on April 3, 1990. Petitioner is correct to the extent that an applicant has up to six months from the date of the Office action within which to respond, provided that a petition for three-month extension and



appropriate fee are submitted therewith. The petition and fee must be submitted before expiration of the six-month statutory period. See 37 CFR § 1.136(a). According to the question, however, Jones did not file a petition and appropriate fee before the expiration of the six-month statutory period. Therefore, the Jones application became abandoned the day following April 3, 1990, or April 4, 1990. The petition to revive the application for unintentional abandonment, filed May 31, 1991, and thus, more than a year after the abandonment date of April 4, 1990, is properly denied.

Question 38

Petitioner concedes that the model answer of a) is correct but argues that his answer, b), is also correct. Petitioner's rationale is that if a product-by-process claim is patentable, the process must be patentable.

Product-by-process claims are permissible, for example, in cases where the product is incapable of description on its own. It does not follow, however, that if the product is patentable the process itself must be patentable. See, e.g., In re Durden, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985) and cases cited therein.

Question 41

Petitioner argues that model answer c) is both misleading and ambiguous, and that his answer b) is more correct than any of the other choices.

Petitioner claims the model answer is misleading and

ambiguous because it says nothing about the Wilson reference. The question, however, asks which of the following items of information would be "relevant" to overcoming the rejection of the claims without modifying or amending the claims. It would be relevant that Jones' invention can be shown to possess unexpected superior properties over the relevant subject matter disclosed by Frank, i.e., answer c). That information is relevant regardless of what information is available with regard to the Wilson reference.

Answer b) is incorrect because feature B, while stated to be within the broad scope of each of the rejected claims, is not specifically set forth as a limitation in any of the claims. Petitioner's argument indicates that he does not understand the statement that a feature is within the broad scope of a claim but not a limitation of the claim. A simple example will illustrate this statement. Five as the number of legs disclosed and exemplified in a specification for an inventive chair is within the broad scope of a claim to a "multi-legged chair" yet is not a limitation of the claim.

#### Question 46

Contrary to petitioner's argument, an ordinary and reasonable patent practitioner would not believe that the July 25, 1991 amendment copying claims from a recently issued patent but not responding to the rejection under 35 U.S.C. 112 was a full response to the first Office action, even though the second Office action makes no mention of a response being due


for the first Office action. Moreover, whether a practitioner would normally file a single response to both Office actions by September 12, 1991 is irrelevant. The question asks when responses to the Office actions are due.

Question 50

Petitioner argues that the correct answer would be for Smith to immediately prepare and file a response to the Office action before the application goes abandoned. Petitioner's argument presupposes that there was only one way for Smith to have met his professional responsibility with regard to representing Jones. In professional responsibility matters, there is frequently more than one way for a practitioner to act correctly. Whether or not what petitioner argues is "the" correct answer would have met Smith's professional responsibility is beside the point. That answer was not a choice in the question. Of the five choices offered as possible answers for this question, only e) is proper.

CONCLUSION

No points have been added to petitioner's score of 62.  
The decision of the Director of February 11, 1992 is affirmed.  
Therefore, this petition is denied.

  
EDWARD R. KAZENSKE  
Director of Interdisciplinary  
Programs